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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,239

09/20/2005

Warena Joseph Sadlier

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EXAMINER

BRACE, EVERETT M

ART UNIT

PAPER NUMBER

4155

MAIL DATE

DELIVERY MODE

03/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/524,239

**Applicant(s)**

SADLIER, WARENA JOSEPH

**Examiner**

EVERETT M. BRACE

**Art Unit**

4155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date 5/13/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 11 recites the limitation "tile spider". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

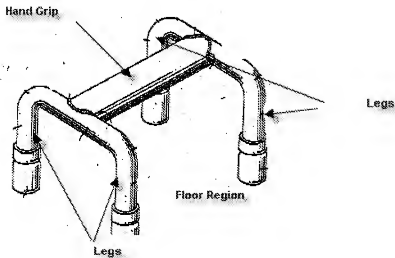
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Andrew Hilt SR (US 2817347 A).

Regarding Claim 1, Hilt discloses a tool including the following:

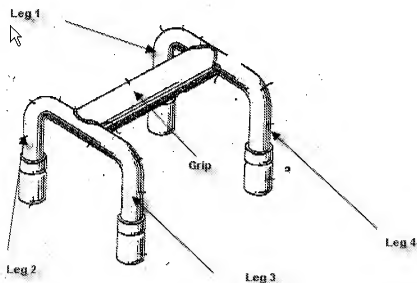
a. A raised hand grip mounted on a plurality of legs splayed outwardly and downwardly relative to the hand grip region to thereby form a hand rest raised to a working height above a floor or the like surface on which the legs are resting.



The examiner notes that the phrase “for use in a method of laying floor tiles” in the claim preamble is intended use language. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 1647 (1987)

Regarding Claim 2, Hilt discloses a grip region raised about 100mm above the level of the bottom of the legs. (Fig. 2, Item 12 (Grip), (Item 20 (Bottom of leg))). While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of the claims. See *In re Mraz*, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972). The examiner notes that the distance from the bottom of the leg to the hand grip appears to be about 100mm thus meeting the limitation stated in claim 2.

Regarding Claim 3, Hilt discloses a tool wherein the grip is raised on four legs.



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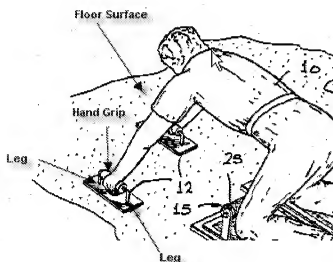
Regarding Claim 5, Hilt discloses legs that are of a tubular construction. (Column 2, Lines 24-30)

Regarding Claim 6, Hilt discloses inverted U shaped legs. (Column 2, Lines 27-30)

Claims 1, and 7, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hammond (4,346,784).

Regarding Claim 1, Hammond discloses a tool including the following:

a. A raised hand grip mounted on a plurality of legs splayed outwardly and downwardly relative to the hand grip region to thereby form a hand rest raised to a working height above a floor or the like surface on which the legs are resting.



The examiner notes that the phrase “for use in a method of laying floor tiles” in the claim preamble is intended use language. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 1647 (1987)

Regarding Claim 7, Hammond, discloses a method wherein the tool is placed in laid adhesive on an area to be tiled so a tiler can rest his or her hands on the grip region. (Fig. 1, Item 12),(Fig. 1, Item 11). Examiner notes that concrete meets the broad limitation of adhesive. With respect to the recitation of “can walk, stand, rest [a] hand or foot”, it has been held that the recitation that an element is “capable of” performing a

function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138. In this case, Hammond is clearly capable of like performance and, thus, anticipates the claim.

Regarding Claim 8 Hammond, discloses a method wherein a tiler can step in an adhesive by using one or more of the tools to effect more work while supporting themselves by hand or foot. (Fig.1). With respect to the recitation of "can step in and over laid...adhesive", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138. In this case, Hammond is clearly capable of like performance and, thus, anticipates the claim.

Regarding Claim 9, Hammond discloses a method wherein "the tool is placed...so a tiler can walk....or step region to thereby make the tiler's task easier. Examiner notes that the it would have been obvious to one of ordinary skill in the art at the time of invention to place Item 12 on a dry tile or adhesive free area so a tiler can walk, or rest his or hand on the foot grip region.

Regarding claim 10, Hammond discloses wherein the tool is used as island platform to work from into otherwise unreachable prepared areas, see Figure above, for example.



Regarding Claim 11, Hammond discloses a method wherein:

- a. The use of more than one tile tool allows the tiler to walk into a prepared area.. (Fig. 1, Item 12) With respect to the recitation of "allows the tiler to walk into a prepared area", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138. Examiner notes that by standing on Item 12 one is capable of walking into a prepared area.
- b. allows the tiler to maintain a straight back and even shoulders while extending into and over a work area. (Fig. 1) Further, being dimensionless, this is almost entirely without patentable weight, if any, and would necessarily be contingent upon the size and shape of the one tiling.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andre Hilt Sr. (2,817,347)

Regarding Claim 2, Hilt discloses the claimed invention except for the grip being explicitly 100mm above the level of the bottoms. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the grip 100mm above the level of the bottom legs, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding Claim 4, Hilt discloses the claimed invention except for a grip region being constructed from a length of box or rectangular metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the grip region from a length of box or rectangular section metal, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23. Examiner notes that the function of the device stays the same whether the grip region is round or square.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hammond (4,346,784).

Regarding Claim 9, Hammond discloses a method wherein "the tool is placed...so a tiler can walk....or step region to thereby make the tiler's task easier. Examiner notes that the it would have been obvious to one of ordinary skill in the art at the time of invention to place Item 12 on a dry tile or adhesive free area so a tiler can walk, or rest his or hand on the foot grip region.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVERETT M. BRACE whose telephone number is (571)270-3732. The examiner can normally be reached on Monday-Friday, 8:00 a.m.-5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571)272-2001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor Batson/  
Vic Batson  
Supervisory Patent Examiner  
Art Unit 4155

EMB